



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,045	09/15/2000	Stefan Vilsmeier	SCHWP0129US	5003

7590 11/15/2004  
Don W. Bulson, Esq.  
Renner, Otto, Boisselle & Sklar, LLP  
19th Floor  
1621 Euclid Ave.  
Cleveland, OH 44115

EXAMINER
----------

KIM, CHONG R

ART UNIT	PAPER NUMBER
----------	--------------

2623

DATE MAILED: 11/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/662,045

Applicant(s)

VILSMEIER ET AL.

Examiner

Charles Kim

Art Unit

2623

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): 112 first paragraph rejections.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: \_\_\_\_\_

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

*Jon Chang*  
Jon Chang  
Primary Examiner

Continuation of 5. does NOT place the application in condition for allowance because: Applicants argue (page 6) that their claimed invention (claim 1) differs from the prior art because "there is no motivation to combine Cosman and Nayar." The Examiner disagrees. Cosman is concerned with mapping a three-dimensional shape of an object, more specifically a patient's head, and providing a three dimensional graphic representation of the head for surgical analysis [col. 10, lines 59-62 and figure 5]. Cosman explains that this three-dimensional graphic representation is of vital importance to surgeons, since it provides them with the capability of visualizing the operating area (col. 1, lines 24-31).

Nayar is also concerned with mapping a three-dimensional shape of an object (page 218). Nayar explains that his method enhances the accuracy of the three-dimensional mapping process (abstract). Nayar also explains that his method can be implemented in a variety of imaging applications (abstract).

Cosman and Nayar are combinable because they are both concerned with image processing methods that deal with mapping a three-dimensional shape of an object. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the three-dimensional mapping process of Cosman in view of Nayar. The suggestion/motivation for doing so would have been to enhance the surgical procedure by providing an accurate three-dimensional graphic representation of the patient's head; thereby providing the surgeons with an accurate visualization of the operating area.

Applicants further argue (page 7) that their claimed invention (claim 19) differs from the prior art because "neither Cosman nor Nayar, taken alone or in combination, disclose or fairly suggest assigning a location and shape of a mapped three-dimensional body part in a navigation system based on the position of at least one marker capture by the camera." The Examiner disagrees. Cosman explains that the position of the index markers are utilized to locate and define the three-dimensional object (col. 5, lines 44-62 and figure 5). Note that the position of the markers (558A, 558B, 558C) in figure 5 assigns a shape and location of the mapped three-dimensional body part..